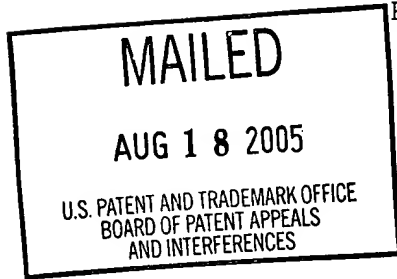


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. PRATT

Appeal No. 2005-1583
Application 08/924,785

ON BRIEF

Before THOMAS, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 44, 62-64 and 67-74, which constitute all the claims pending in the application.

The disclosed invention pertains to a method and apparatus modifying available remote device management services of a network device.

Representative claim 44 is reproduced as follows:

44. A method for modifying available remote device management services of a network device, the method comprising:

obtaining a new downloadable unit for performing a new service, the new downloadable unit including:

a communicator component for establishing a communications channel between a remote client and the network device,

an interface component for enabling the remote client to communicate with the new downloadable unit, and

a configuration component for managing the network device;

retrieving a network device control software program binary file having an embedded old downloadable unit for performing an old service from the network device;

substituting the old downloadable unit with the new downloadable unit; and

loading the network device control software program binary file having the new downloadable unit embedded in the binary file onto the network device,

wherein the network device control software program is executed by the network device.

The examiner relies on the following references:

Nakagawa et al. (Nakagawa)	5,835,911	Nov. 10, 1998 (filed Aug. 21, 1995)
Madany	5,922,050	July 13, 1999 (filed July 02, 1996)
Beard	6,067,577	May 23, 2000 (filed Sep. 30, 1996)

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Claims 44, 62-64 and 67-74 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Madany in view of Beard and Nakagawa.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 44 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to representative claim 44, the examiner has indicated the teachings of the applied prior art upon which the rejection is based [answer, pages 3-5]. Appellant argues that the features disclosed in Beard and Nakagawa may not be properly combined with the features disclosed in Madany. Specifically, appellant argues that Madany is on one end of the cost and processing power spectrum while Beard and Nakagawa are at the other end. Appellant argues that Madany does not teach a general purpose computer as being one of the example connected devices. Appellant notes that there is no discussion in Madany of the control logic replacing the existing dedicated logic. Appellant also argues that the examiner has failed to provide a proper motivation for the proposed combination. Specifically, appellant argues that the examiner has asserted individual motivations with respect to prior art differences with no single motivation for the invention as a whole. Appellant argues that there is no basis for embedding the applet in Madany as opposed to just storing the applet as taught by Madany. Appellant notes that Nakagawa relates to changing software on a general purpose computer which would have no application to the dedicated devices of Madany [brief, pages 5-16].

The examiner responds that many of appellant's arguments relate to features of the invention which are not reflected in the appealed claims. The examiner also responds that the broadest reasonable interpretation of claim 44 is that it requires nothing more than file substitution. The examiner also notes that since Madany teaches that his system is compatible with the development of new processors, then he teaches future developed program codes [answer, pages 6-10].

Appellant responds that the examiner failed to properly address the arguments set forth in the main brief. Appellant repeats the arguments of the main brief and argues that these arguments have been substantially unrefuted. Specifically, appellant argues that Madany does not teach that a connected device could be a general purpose computer. Appellant also argues that Madany teaches a single stored applet, and therefore, there is no replacement of this applet taught by Madany [reply brief, pages 2-10].

We will not sustain the examiner's rejection of any of the claims on appeal. Most importantly, we agree with appellant that there is no basis for modifying the teachings of Madany with the teachings of Beard and Nakagawa except in an improper attempt to reconstruct the claimed invention in hindsight. The devices

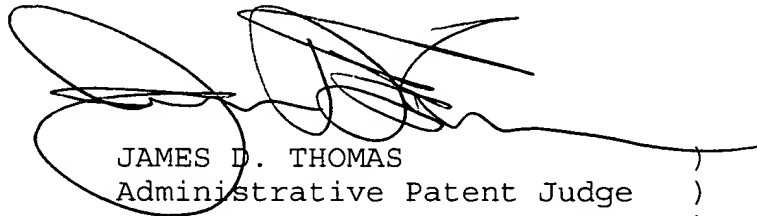
16, 18 and 20 of Madany are low cost simple devices which are dedicated to performing a simple function. The whole point of Madany is that the processing required to control these dedicated devices is performed by network computers 10 and/or 12. Even though Madany simply states that a dedicated device could be a computer, the computer still would require that a network computer perform the required processing. This operation would suggest to the artisan that the connected computer would be a simple dedicated computer which is incapable of performing its own processing. There is nothing in Madany which would lead the artisan to believe that the applets stored in the read-only memory are capable of being updated. We agree with appellant that the low cost goal taught by Madany would teach away from the idea of having applets which can be updated within the Madany devices. The fact that the Madany device is compatible with future computers relates to the fact that the applet is written in a computer-independent form and has nothing to do with the applet itself being replaceable with new versions of the applet. Although the claimed invention may appear to be nothing more than a simple file replacement system to the examiner, the examiner's rationale for modifying the teachings of Madany with the teachings of Beard and Nakagawa makes no sense in view of the

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limited teachings of Madany and, as noted above, appears to be based on an improper hindsight reconstruction.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 44, 62-64 and 67-74 is reversed.

REVERSED


JAMES D. THOMAS
Administrative Patent Judge)


ERROL A. KRASS
Administrative Patent Judge)


JERRY SMITH
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

JS/ki

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